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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|------------------------------|------------------------|
| 10/808,775 | 03/24/2004 | Trevor Clark Thompson | 034152-003 | 5913 |
| 21839 7590 05/17/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404 | | | EXAMINER WILLIS, RANDAL L | |
| | | | ART UNIT 2629 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/808,775 | Applicant(s) THOMPSON ET AL. | |
| | Examiner Randal L. Willis | Art Unit 2629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/07/04 and 4/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to application No. 10/808775 filed March 24th, 2004. Claims 1-10 are currently pending and have been examined.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on March 12th, 2004 and September 7th, 2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Objections

3. Claim 9 objected to because of the following informalities: Improperly depends upon claim 8, for examination purposes will be read to depend upon claim 4. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1,2,4 and 10 rejected under 35 U.S.C. 102(b) as being anticipated by Florence (2002/0005835).

Apropos claim 1, Florence teaches:

A computer pointing device (Computer mouse, Fig. 1) comprising:

an outer surface having a first portion (Housing 110, Fig. 1) and a second portion (Actuators 112 and 114, Fig. 1),

said first portion operative to support a user's palm when said computer pointing device is placed within said user's hand (Housing 110 is body of mouse, Fig. 1),

said second portion having at least one movable panel, placed within reach of at least one user's finger, operative to transmit a selection command from said computer pointing device to a computer by deflection of said at least one movable panel by said at least one user's finger (112 and 114 actuators for mouse buttons, Fig. 1 and [0020]);

a first appliqué attached to said first portion of said outer surface
(cover member 122, Fig. 1): and

a second appliqué attached to said at least one movable panel (cover
members 118 and 120, Fig. 1).

Apropos claim 2, Florence teaches:

A computer pointing device as recited in claim 1, wherein said first appliqué
and said second appliqué are attached by means of an adhesive ([0021]
lines 3-4).

Apropos claim 4, Florence teaches:

A computer pointing device as recited in claim 1, wherein said first appliqué
and said second appliqué have a textured top surface ([0006] lines 7-9).

Apropos claim 10, Florence teaches:

A computer pointing device as recited in claim 1, wherein said first appliqué
and said second appliqué have advertising printed thereon (Text such as 126
on cover 122 shown in Fig. 2 can be used as advertising. [0009] line 6).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 3,6,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florence (2002/0005835) in view of Lai (2003/0090464).

Apropos claim 3, Florence fails to explicitly teach:

A computer pointing device as recited in claim 1, wherein said first appliqué and said second appliqué are flexible and conform to a non-planar surface.

In the same field of adhesively attached covers for computer mice, Lai teaches a soft foam rubber cover that is aesthetically pleasing and

comfortable for the user that conforms to the exterior surface of the mouse ([0010]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have the covers of Florence made of a soft pliable material as taught by Lai in order to reduce user discomfort from sweat or the like building up on the mouse ([0004]).

Apropos claim 6, Florence and Lai fail to explicitly teach:

wherein said textured top surface is made from leather.

However examiner takes note that leather is a material common in fabricating grips and the like, and therefore would be obvious to one of ordinary skill to create covers the covers as taught by Florence and Lai with a leather clad surface for enhance user comfort and aesthetic appeal.

Apropos claim 8, Lai further teaches:

A computer pointing device as recited in claim 4, wherein said textured top surface is made from plastic or rubber (Rubber skin 2, [0010]).

Apropos claim 9, Lai further teaches:

A computer pointing device as recited in claim 8, wherein said textured top surface is made from a foam material (soft foam rubber 2, [0010]).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florence in view of Harskamp (6016,138).

Apropos claim 7 Florence and Lai fail to explicitly teach:
wherein said textured top surface is made from a pliable gel.

However in the same field of computer mice, Harskamp teaches a gel-like cushion for the computer mouse that will conform to the users hand (Col 4 lines 51-54).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to create covers as taught by Florence containing a gel-like material as taught by Harskamp to improve user comfort of the mouse device (Col 3 line 2-3).

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florence in view of Song (6,135,876).

Apropos claims 5, Lai teaches:

5. A computer pointing device as recited in claim 4, wherein said textured top surface is comfortable [0006] line 9

However Lai fails to explicitly teach the surface being made from a fabric.

In the same field of computer mice, Song teaches that a fabric covering is comfortable to hold (Col 2 lines 33-37).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use fabric as taught by Song as the surface of the covers taught by Lai and Florence in order to provide a comfortable surface for the user to hold on to.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Smith (2002/0126093) for teaching a fabric cover for a mouse.
- b. Alsleben (6,816,149) for teaching adhesive panels attached to a mouse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal L. Willis whose telephone

number is (571) 270-1461. The examiner can normally be reached on Monday to Friday from 7:30am to 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RLW

AMR A. AWAD
SUPERVISORY PATENT EXAMINER

